

**IN THE DRAWINGS:**

The attached drawing(s) include changes to FIG. 1. The sheet containing FIG. 1 replaces the original sheet including FIG. 1. For the convenience of the Examiner, an annotated sheet showing the changes made is attached.

In the Office Action at item 4, the Examiner objected to the drawings. In order to overcome these objections, replacement FIG. 1 is amended to provide a description of a system according to an aspect of the invention. In FIG. 1, appropriate labels are provided for illustrated elements 101-111, 121-122, and 131-133 as "RECEPTION PROGRAM" 101, "QUOTE ESTIMATE PROGRAM" 102, "SIGN-UP PROGRAM" 103, "DATA PROCESSING DEVICE" 104, "DATABASE UPDATE PROGRAM" 105, "PERSONAL POSSESSIONS DATABASE" 106, "USER DATABASE" 107, "PRODUCT MASTER" 108, "INSURER MASTER" 109, "HISTORY DATABASE" 110 and "MAINTENANCE MASTER DATABASE" 111, "INPUT PART" 121, "OUTPUT PART" 122, "USER TERMINAL" 131, "INSURER TERMINAL" 132, and "MANUFACTURER TERMINAL" 133. (See, for example pages 4-6, starting at line 30 of the specification.)

Approval of these changes to the Drawings is respectfully requested.

## REMARKS

In accordance with the foregoing, the drawings and claims 5 and 9-12 are amended. No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claims are respectfully requested. Claims 1-4 are cancelled without prejudice or disclaimer.

Claims 5-12 are pending and under consideration.

## CLAIM AMENDMENTS

Claims 9-12 are amended to respectively recite a computer system, a method and a computer-readable medium, using claim 9 as an example, including "a second computer storage part in which at least an identifier of a product and guarantee information related to said product are stored for each product available from said at least one manufacturer." (See, for example, claim 5).

Claims 5 and 9-12 are further amended for form.

## ITEM 4: OBJECTION TO THE DRAWINGS

In item 4 of the Action, the Examiner objects to FIG. 1 contending "it does not provide enough detail or description of the depicted system."

FIG. 1 is amended herein so as to provide description of the system. In FIG. 1, appropriate labels are provided for illustrated elements 101-111, 121-122, and 131-133. (See, for example pages 4-6., starting at line 30 of the specification.)

Withdrawal of the objection is requested.

## ITEM 5: REJECTION OF CLAIMS 5-11 UNDER 35 U.S.C. §101

In item 5, the Examiner rejects claims 5-11 under 35 U.S.C. §101 contending that the claimed invention is directed to non-statutory subject matter. The Examiner contends that claims 5 and 9, for example "lack a clear and deliberate nexus to any computerized or electronic device within the body of the claim." (Action at page 4). The Examiner also contends that claims 10-11 are not "within the technological arts as explained." (Action at page 5).

Claims 5 and 9-11 are amended herein to address the Examiner's concerns.

In addition, Applicant respectfully points out to the Examiner that in the precedential decision of *Ex Parte Lundgren*, Appeal 2003--2088 (October 2005), the USPTO Board of Patent Appeals and Interferences has ruled "that there is currently no judicially recognized 'technological arts' test to determine patent eligible subject matter under § 101." That is, the rejection lacks a foundation in the law.

Applicant submits that claims 5-11 comply with 35 U.S.C. §101 and request the rejection be withdrawn.

**ITEM 7: REJECTION OF CLAIMS 9-12 UNDER 35 U.S.C. §102(e) AS BEING ANTICIPATED BY JOAO (U.S.P. 6,347,302)**

Claims 9-12, all as amended, recite a computer system, a method and a computer readable medium, using claim 9 as an example, including "a second computer storage part in which at least an identifier of a product and guarantee information related to said product are stored for each product available from said at least one manufacturer." (See, for example, claim 5).

On page 10, the Action concedes that Joao does not teach "a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured."

As provided in MPEP §706.02 entitled Rejection on Prior Art, anticipation requires that the reference must teach every aspect of a claimed invention. Joao does not support an anticipatory-type rejection by not describing features recited in the claims 9-12, all amended.

**Summary**

Since features recited by claims 9-12 are not taught by the cited art, the rejection should be withdrawn and claims 9-12 allowed.

**ITEMS 11-13: REJECTION OF CLAIMS 5-8 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER JOAO IN VIEW OF COMBINATIONS OF SOLOMON (U.S.P. 6,847,935), OFFICIAL NOTICE TAKEN BY THE EXAMINER, LOCKWOOD (U.S.P. 4,567,359), AND**

In item 11, the Examiner rejects independent claim under 35 U.S.C. §103(a) as being unpatentable over Joao in view Solomon (U.S.P. 6,847,935). In items 11-13, the Examiner rejects dependent claim 6-8 under 35 U.S.C. §103(a) as being unpatentable over Joao in view of combinations of Solomon, Official Notice taken by the Examiner, and Lockwood (U.S.P. 4,567,359). The rejection is traversed.

Independent claim 5, as amended, recites a computer system for mediating between at least one user and at least one manufacturer via a network including "a first computer storage part in which purchase information related to products possessed by said at least one user is stored; a second computer storage part in which at least an identifier of a product and guarantee information related to said product are stored for each product available from said at least one manufacturer; and an insurance request part which requests insurance on said products according to said purchase information stored in said first computer storage part and information in said second computer storage." (Emphasis added).

The Action concedes that Jao does not teach "a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured." (Action at page 10).

However, the Examiner contends it would have been obvious to modify the system of Joao with the teaching of Solomon:

to store the recited data. As suggested by Solomon, one would have been motivated to include this feature to provide the system with greater flexibility, especially in accommodating the needs and preferences of the consumers.

(Action at page 11).

Applicant submits that Solomon is nonanalogous art and does not teach or suggest "insurance." According to an aspect of the present invention, the recited second computer storage part is provided for requesting insurance on products regardless if the user knows detailed information about the product they wish to purchase, and the present invention fills in the missing information.

Accordingly Applicant submits that features recited by independent claim 5 (and respective dependent claims 6-8) are not taught by even an *arguendo* combination of the cited art.

Further, Applicant submits that one skilled in the art would not look to Solomon that is directed to "rebate processing" to modify processing of "insurance." Further, as set forth in MPEP §2144. 04:

(t)he mere fact that a worker in the art could rearrange the parts of the reference device . . . is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation . . . without the benefit of appellant's specification, to make the necessary changes in the reference device.

In addition, in rejecting claims dependent claim 7 the Examiner indicates that "it is old and well known in the insurance art to carry multiple coverages on a single contract or to insure more than one item on a single contract." The Applicant respectfully traverses the Examiner's statement and demands the Examiner produce authority for the statement. As set forth in explained in M.P.E.P. § 2144.03(E):

any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

## Summary

Since *prima facie* obviousness is not established the rejection should be withdrawn, and

claims 5-8 allowed.

**CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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# ANNOTATED SHEET

FIG.1

